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EXAMINER

PATEL, GAUTAM

ART UNIT	PAPER NUMBER
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2655

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DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/819,849

**Applicant(s)**

SHISHIDO, YUKIO

**Examiner**

Gautam R. Patel

**Art Unit**

2655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 3, 11, 12, 21 and 27-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7-10, 16-20 and 24-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 1-29 are pending for the examination.

#### Election/Restriction

2. Claims 3, 11-12, 21 and 27-29 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b) as being drawn to figs. 9; the second embodiment [as per the Applicants]. Election was made with traverse of claims 1-2, 4-9, 13-20 and 22-26.

Applicant's election with traverse of group a in Paper No. 6 is acknowledged. The traversal is on the ground(s) that "the embodiment of Figure 8 is essentially contained in the embodiment of Figure 9, as steps S1-S9 corresponds with steps ...". Accordingly, it is believed that it is appropriate to examine claims covering both embodiments of Figures 8 and 9.

This is not found persuasive because, even though fig. 9 may contain parts of fig. 8; fig. 9 does have several new steps [such as S19 S16 etc.] which are not covered by fig. 8 at all. Also the Applicants had choice of electing fig. 9 as their choice of elections so as to cover both embodiments, which however was not done.

As to the argument regarding all claims are generic, the examiner agrees with the Applicants that at this point claims 1, 10, 19 and 26 does look generic and are considered as such.

The requirement is still deemed proper and is therefore made FINAL.

The Applicants are urged to cancel non-elected claims.

### NOTES & REMARKS

3. There are arts [such as Ando] that reads on these claim. This art was not used in this rejection because of its in between date. However if translation of Priority papers is not received in time, this art may be used in the future.

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4. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119(a)-(d), which papers have been placed of record in the file.

#### **Drawings/Objection**

5. The drawings are objected for following reasons:

The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, “a data pseudo-erasing means, a packet positioning recording means, a data discriminating means, a data recording controller, a data pseudo-erasing controller and a packet position recording controller” must be shown or the feature cancelled from the claims. **No new matter should be entered.**

Applicant is required to submit a proposed drawing correction in response to this Office Action. Any proposal by the applicant for amendment of the drawings to cure defects must consist of following:

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment, and may be ***accompanied by a marked-up copy of one or more of the figures being amended, with annotations.*** Any replacement drawing sheet ***must be identified in the top margin as “Replacement Sheet”*** and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. ***Any marked-up (annotated) copy showing changes must be labeled “Annotated Marked-up Drawings” and accompany the replacement sheet in the amendment (e.g., as an appendix).***

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Corrections are required.

### **Specification**

6. The disclosure is objected for following reasons.

The title of the invention is neither precise nor descriptive. A new title is required which should include, using twenty words or fewer, claimed features that differentiate the invention from the Prior Art. It is recommended that the title should reflect the gist of or the improvement of the present invention.

Correction is required.

### **Claim Rejections - 35 U.S.C. § 112**

7. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4-6, 13-15 and 22-23 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Specification Page 5-6, simply states that "data pseudo erasing means simply erases content information of the track containing the data". The specification does not disclose at all that "data erase means is erasing the data which as been pseudo-erased".

Claims 13-15 and 22-23 has same problem.

8. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

a. Claims 4-6, 13-15 and 22-2 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 4, line 2 "data erase means for erasing the data which has been pseudo-erased." is confusing and unclear. It not clear how data can be erased again that has already been erased previously.

Rest of the claims have the same problem.

b. Claim 6, 15 and 23 are also rejected for proper antecedent basis

Claim 6, lines 8-11 the scope of "means discriminates that the new data up to the end position of the packet is **not** be updated" lacks proper antecedent basis.

Claims 15 and 23 has same problem.

### **Claim Rejections - 35 U.S.C. § 102**

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-2, 7-10 16-20 and 24-26 are rejected under 35 U.S.C. § 102(e) as being anticipated by Hashimoto et al., US. patent 6,370,096 (hereafter Hashimoto).

As to claim 1, Hashimoto discloses the invention as claimed of a data recording apparatus [see Figs. 1-9, especially 1-2 and 5-8] including data recording means, data pseudo-erasing means, and packet position recording means, comprising:

data recording means [fig. 1, unit 3] for recording data on a packet basis onto a track of an optical recording medium [col. 4, lines 15-23];

data pseudo-erasing means [fig. 1, unit 9] for erasing contents information of the track containing the data, thereby pseudo-erasing the data [col. 4, lines 15-67]; and

packet position recording means [fig. 1, unit 9] for recording on the optical recording medium information indicating an end position of the packet containing the data [col. 4, lines 15-67],

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wherein the data recording means records new data onto the track where the data has been pseudo-erased, in accordance with the information indicating the end position of the packet [col. 5, lines 9-37].

10. The aforementioned claim 2, recites the following elements, inter alia, disclosed in Hashimoto:

the packet position recording means records the information indicating the end position of the packet in a pre-gap arranged on the track [col. 8, lines 5-38].

11. The aforementioned claim 7, recites the following elements, inter alia, disclosed in Hashimoto:

the packet position recording means records on the optical recording medium information indicating the end position of the packet containing the new data [col. 11, lines 16-35].

12. The aforementioned claim 8, recites the following elements, inter alia, disclosed in Hashimoto:

pseudo-erased data recording means [fig. 1, units 3, 8 and 9] for recording on the optical recording medium information indicating that the data has been pseudo-erased [col. 7, lines 18-67].

13. The aforementioned claim 9, recites the following elements, inter alia, disclosed in Hashimoto:

the optical recording medium comprises at least one logical track capable of recording data and each of the logical tracks comprises a plurality of the packets [col. 5, lines 45-64 and fig. 2A].

14. The aforementioned claim 10, recites the following elements, inter alia, disclosed in Hashimoto:

an optical head [fig. 1, unit 3] for irradiating light to an optical recording medium [fig. 1, unit 1] [col. 4, lines 15-23];

a data recording controller [fig. 1, unit 9] for controlling the optical head so as to record data on a packet basis onto the optical recording medium; a data pseudo-erasing controller for controlling the optical head so as to erase contents information of a track having the data recorded and pseudo-erase the data [col. 4, lines 15-67]; and

a packet position recording controller [fig. 1, unit 9] for controlling the optical head so as to record on the optical recording medium information indicating an end position of the packet in which the data has been recorded [col. 8, lines 16-35];

wherein the data recording controller, in accordance with the information indicating the end position of the packet, records new data onto the track where the data has been pseudo-erased [col. 8, lines 16-35].

15. As to claims 16-18, they are system claims corresponding to claims 7-9 respectively and they are therefore rejected for the same reasons set forth in the rejection of claims 7-9 respectively, *supra*.

16. The aforementioned claim 19, recites the following elements, *inter alia*, disclosed in Hashimoto:

recording data on a packet basis onto a track of an optical recording medium and erasing contents information of the track containing the data, thereby pseudo erasing the data [col. 5, lines 9-37];

recording on an optical recording medium information indicating the end position of the packet containing the data [col. 8, lines 5-38]; and

a step of records a new data onto the track where the data has been pseudo - erased in accordance with the information indicating the end position of the packet [col. 5, lines 9-37].



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17. As to claim 20, it is drawn to a method claim corresponding to the apparatus of claim 2, and is therefore rejected for similar reasons set forth in the rejection of claim 2, supra.

18. As to claims 24-25, they are method claims corresponding to claims 7-8 respectively and they are therefore rejected for the similar reasons set forth in the rejection of claims 24-25 respectively, supra.

19. As to claim 26, it is drawn to an apparatus claim corresponding to the apparatus of claim 1, and is therefore, rejected for similar reasons set forth in the rejection of claim 2, supra.

20. A search based on the best understanding of the claims has been made to find the most pertinent art, but no statement about invention will be appropriate at this time regarding the allowableness of claims 4-6, 13-15 and 22-23 and no art rejection will be made in this office action regarding the claims 4-6, 13-15 and 22-23, due to the high speculation required to interpret the claims because of their indefiniteness under 35 U.S.C. 112, 1st and 2nd paragraphs as noted above (see *In re Steele*, 134 USPQ 292).

#### **Allowable Subject Matter Information**

21. Claims 6, 15 and 23 has allowable subject matter. These claims will be objected as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. This is subject to overcoming 112 first and, two 112 second rejections.

#### **Other prior art cited**

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Ando et al. (US. patent 6,373,803) "Stream data generation method ..".

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- b. Ando et al. (US. patent 6,456,783) "Data structure of stream data ..".

**Contact Information**

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam R. Patel whose telephone number is (703) 308-7940. The examiner can normally be reached on Monday through Thursday from 7:30 to 6.

The appropriate fax number for the organization (Group 2650) where this application or proceeding is assigned is (703) 872-9314.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Doris To can be reached on (703) 305-4827.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-4700 or the group Customer Service section whose telephone number is (703) 306-0377.

**GAUTAM R. PATEL  
PRIMARY EXAMINER**

Gautam R. Patel  
Primary Examiner  
Group Art Unit 2655

May 19, 2004

A handwritten signature in black ink, appearing to read 'Gautam R. Patel', is written over a horizontal line.